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David Benjamin Auerbach

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EXAMINER

HICKS, MICHAEL J

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,052

Applicant(s)

AUERBACH ET AL.

Examiner

Michael J. Hicks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, and 47-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-72 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-72 Pending.

***Election/Restrictions***

2. It is noted that Brain Hoffman indicated that Claim Grouping I will be elected with traverse via telephone on 10/27/2006, as such, only the claims from elected Claim Group I will be addressed in the instant Office Action.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-25, and 47-61 are drawn to a method and computer readable medium for identifying an aspect within an article and generating search query results based on the aspect. Classified in Class 707, Subclass 3.
  - II. Claims 26-46 and 62-72 are drawn to a method and computer readable medium for identifying an aspect within an article and generating a request based on the aspect which is used to refine the formulation of forthcoming search queries. Classified in Class 707, Subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has

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separate utility such as to provide query results to a user. Invention Group II adds the utility of enabling the user to refine queries that will be generated in the future, therefore increasing the accuracy of the search results to Group I, and has separate utility in that Group 2 could be used to generate requests not specifically related to the generation of search queries and query result, such as generating a request asking the user if they wish the identified aspect to be displayed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for Group I is not required for Groups II, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 47-61 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Applicants description of computer readable medium on Page 5, Paragraph 11 of Applicants specification indicates that the computer readable medium on which the program code is encoded may include a transmission medium, which qualifies as a signal.

"Embodiments of computer-readable media include, but are not limited to, an electronic, optical, magnetic, or other storage or **transmission device** capable of providing a processor, such as the processor 110 of client 102a, with computer-readable instructions. Other examples of suitable media include, but are not limited to, a floppy disk, CD-ROM, DVD, magnetic disk, memory chip, ROM, RAM, an ASIC, a configured processor, all optical media, all magnetic tape or other magnetic media, **or any other medium from which a computer processor can read instructions**. Also, various **other forms of computer-readable media may transmit or carry instructions to a computer, including a router, private or public network, or other transmission device or channel, both wired and wireless.**"

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

First, a claimed signal is clearly not a "process" under Sec. 101 because it is not a series of steps. The other three Sec. 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents Sec. 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some

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function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), *cert. denied*, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute

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and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, Sec. 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of Sec. 101.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 25 rejected under 35 U.S.C. 102(e) as being anticipated by Musgrove et al. (U.S. Pre-Grant Publication Number 2005/0065909 and referred to hereinafter as Musgrove).

As per Claim 25, Musgrove discloses a method comprising: identifying an aspect associated with an article (i.e. "...determining word scores of the words in the document based on the frequency of the words in the document, adjusting the word scores of the words by predetermined weightings corresponding to the use of each word in the document, constructing a keyword query search string using words having the highest word scores..." The preceding text excerpt clearly indicates that an aspect associated with an article (e.g. keywords in a web page) are identified.) (Page 2, Paragraph 16); automatically searching a local article index with a user context-dependent search query for a search result associated with the aspect (i.e. "...searching the product records of the products database to identify products satisfying the keyword query search string, assigning product scores to the identified products based on matches to the keyword query search string, parsing the product records to identify word matches in each of the product records and the document, updating the product score by processing the adjusted word scores corresponding to the matched word with the product score of the product for which word matched, and selecting products from the identified products that have the highest updated product scores..." The preceding text excerpt clearly indicates that a local article index (e.g. product database) is automatically searched with the a query associated with the aspect. Note that as the user requested the search be done (paragraph 26), the query is user context-dependant.) (Page 2, Paragraph 16); automatically generating an insert comprising the search result (i.e. "...searching the product records of the products database to identify products satisfying the keyword query search string, assigning product scores to the identified products based on matches to the keyword query search string, parsing the product records to identify word matches in each of the product records and the document, updating the product score by processing the adjusted word scores corresponding to the matched word with the product score of the product for which word matched, and selecting products from the identified products that have the highest updated product scores..." The preceding text excerpt clearly indicates that a search result (e.g. insert) is automatically generated.)



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(Page 2, Paragraph 16); placing the insert into the article such that the insert will be displayed near the aspect when the article is displayed (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be inserted into the article as a link or advertisement.) (Page 9, Paragraph 62); and causing the article to be displayed (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the article (e.g. web page) may be displayed.) (Page 9, Paragraph 62).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8, 11-24, 47-54, and 57-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp et al. (U.S. Patent Number 6,976,053 and referred to hereinafter as Tripp) in view of Phelps ("All you can seek", Special Services, July 1999, Vol.7, Iss. 7, accessed on the web on 10/16/2006 at <http://www.smartcomputing.com/editorial/article.asp?article=articles/archive/g0707/26g07/26g07.asp>).

As per Claims 1 and 47, Tripp discloses a method comprising: identifying an aspect associated with an article (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that before the search is performed, an aspect associated with an article (e.g. file) must be indicated. Note that an aspect may be any information associate with the file, and that the invention, as claimed, does not indicate any automation or computer involvement in identifying the aspect, thus a user searching for known files on the users computer meets the limitation.) (Column 3, Lines 21-38); generating an insert based, at least in part, on the aspect, wherein the insert comprises a search result (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that searching is provided, e.g. an insert in the form of a search result is created.) (Column 3, Lines 32-38).

Tripp fails to disclose causing the insert to be output in association with the aspect.

Phelps discloses causing the insert to be output in association with the aspect (i.e. *"A free product from AltaVista, the same site that helps many searchers make sense of the World Wide Web, can help you figure out your local web, as well. AltaVista Discovery brings the power of Internet search engines and descriptive search results to your desktop. Using AltaVista Discovery, you can search through local or networked hard drives just as you would the Internet. Results appear as they*

*do on most search engine pages, with the first few lines of text displayed along with the file information. Clicking a link in the list opens that file."* The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in relation to the aspect of the article which it pertains to (e.g. the lines of text and file information).) (Page 5, Paragraph5).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include causing the insert to be output in association with the aspect with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 2 and 48, Tripp discloses automatically generating the insert comprises searching an article index for the search result (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that generating the insert (e.g. search result) comprises searching an article/file index.) (Column 3, Lines 32-38).

As per Claims 3 and 49, Tripp discloses the article index comprises an index of articles available on the World Wide Web (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that file index may include files/article available on the world wide web.) (Column 3, Lines 32-38).

As per Claims 4 and 50, Tripp discloses the article index comprises a local article index (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that the article/file index may be an index of local articles/files.) (Column 3, Lines 32-38).

As per Claims 5 and 51, Tripp discloses the local article index comprises a messaging index (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article index may include email messages (e.g. a messaging index.) (Column 3, Lines 49-53).

As per Claims 6 and 52 Tripp discloses searching the article index for the search result comprises generating a user context-dependent search query (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that because the user inputs the query, the query is user context-dependant.) (Column 3, Lines 21-38).

As per Claims 7 and 53, Tripp fails to disclose the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions.

Phelps discloses the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user context-dependant search query will be based on the search options the user has previously selected (e.g. a user action history comprising a plurality of user actions.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 8 and 54, Tripp fails to disclose the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path.

Phelps discloses the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path (i.e. *"A free product from AltaVista, the same site that helps many searchers make sense of the World Wide Web, can help*

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*you figure out your local web, as well. AltaVista Discovery brings the power of Internet search engines and descriptive search results to your desktop. Using AltaVista Discovery, you can search through local or networked hard drives just as you would the Internet. Results appear as they do on most search engine pages, with the first few lines of text displayed along with the file information. Clicking a link in the list opens that file."* The preceding text excerpt clearly indicates that the search result comprises a text snippet.) (Page 5, Paragraph5).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 11 and 57, Tripp Fails to disclose causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article.

Phelps discloses causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article (i.e. *"Once Discovery is up and running, it will make an index of all the documents and E-mail messages on your own hard drive. You can add or delete the locations to look for documents in Discovery's Options, which is accessible by right-clicking the Discovery System Tray icon. To use Discovery, go to the toolbar that appears and pick a Search Space. This space may be the Internet, your documents, your E-mail program, or a variety of other choices. Then, type in a search query just as you would on the Internet (it even allows Boolean terms). Click Search, and results appear on a Web page."*

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The preceding text excerpt clearly indicates that the search result (e.g. text snippet) appears in a browser window separate from the toolbar and the article.) (Page 5, Paragraph 7).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 12 and 58, Tripp Fails to disclose at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that generating the insert (e.g. producing the search result) is based on user preferences in the form of search preferences.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

Phelps discloses at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference.

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect

is based, at least in part, on a user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 13 and 59, Tripp Fails to disclose receiving the user preference.

Phelps discloses receiving the user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user may input the preferences (e.g. the preferences will be received).) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include receiving the user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 14 and 60, Tripp Fails to disclose determining the user preference based, at least in part, on a user action history comprising a plurality of user actions.

Phelps discloses determining the user preference based, at least in part, on a user action history comprising a plurality of user actions (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user preferences are based on a user action history comprising a plurality of user actions (e.g. the user setting the preferences).) (Page 5, Paragraph 8, Page 6, Paragraph 1).



It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include determining the user preference based, at least in part, on a user action history comprising a plurality of user actions with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 15 and 61, Tripp Fails to disclose determining the user preference based, at least in part, on a system analysis.

Phelps discloses determining the user preference based, at least in part, on a system analysis (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that after the user preferences have been set, the preferences will be determined for searching purposes by scanning the system to identify which user preferences the user has selected.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Phelps to include determining the user preference based, at least in part, on a system analysis with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 16 and 37, Tripp discloses the aspect comprises a hyperlink (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers*

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*increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a hyperlink in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claims 17 and 38, Tripp discloses the aspect comprises a title (i.e. "At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a title of/in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claims 18 and 39, Tripp discloses the aspect comprises an image (i.e. "At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet

*searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, an image in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claims 19 and 40, Tripp discloses the aspect comprises a menu item (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a menu item in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claims 20 and 41, Tripp discloses the aspect comprises an input field (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a

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document/file/article they wish, an input field in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claims 21 and 42, Tripp discloses the article comprises a web page (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise a HTML document/web page/Netscape file.) (Column 3, Lines 49-53).

As per Claims 22 and 43, Tripp discloses the article comprises a text document (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise a text/Office document.) (Column 3, Lines 49-53).

As per Claims 23 and 44, Tripp discloses the article comprises an email message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise an email message/Eudora file.) (Column 3, Lines 49-53).

As per Claims 24 and 45, Tripp discloses the article comprises an instant messenger message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and*

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*document formats.*" The preceding text excerpt clearly indicates the article may comprise an instant messenger message (e.g. the instant messenger message could be in the form of a chat log (e.g. text document) or in the form of an email message.) (Column 3, Lines 49-53).

9. Claims 9-10 and 55-56 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view Phelps and further in view of Musgrove.

As per Claims 9 and 55, the Tripp-Phelps invention as described above in relation to Claim 1 fails to disclose causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article.

Musgrove discloses causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be inserted into the article as a link or advertisement.) (Page 9, Paragraph 62).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Musgrove to include causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article with the motivation of associating inserts (e.g. search query results) with articles (e.g. documents) based on the context of the document (Musgrove, Abstract).

As per Claims 10 and 56, the Tripp-Phelps invention as described above in relation to Claim 1 fails to disclose causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect.

Musgrove discloses causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be displayed in the article as an advertisement proximate to the aspect. Note that it is common for advertisements to be cycled/reloaded on web pages, qualifying an advertisement as transient.) (Page 9, Paragraph 62).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Musgrove to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect with the motivation of associating inserts (e.g. search query results) with articles (e.g. documents) based on the context of the document (Musgrove, Abstract).

#### ***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Hicks whose telephone number is (571) 272-2670. The examiner can normally be reached on Monday - Friday 8:30a - 5:00p.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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